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| 09/917,082 | 07/30/2001 | Yehia Awada | PA114-01 | 9110 |

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| EXAMINER |
|---|
| CAPRON, AARON J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | 9 |

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/917,082 | AWADA, YEHIA | |
| | Examiner | Art Unit | |
| | Aaron J. Capron | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

This is a response to the Amendment received on February 11, 2003. Claims 1-20 are pending.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller (U.S. Patent No. 5,975,529; hereafter "de Keller").

de Keller discloses, teaches or suggests a method of playing a game wherein the steps are dealing cards to a player, providing an opportunity for a player to make a wager on a rank of a poker hand from the cards dealt (4:34-35 and 5:8-9), dealing out community cards (4:39-52), providing an opportunity to make a wager based on cards dealt and the community cards (4:35-38), and settling wagers, but does not disclose having a betting round between dealing cards to a player and dealing out the community cards. However, it is notoriously well known in the art at the time the invention was made to incorporate a wager between cards dealt and the community cards in order to increase the pot. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a betting round between dealing cards to a player and dealing out the community cards into de Keller in order to increase the size of the pot.

Claims 2-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller in view of 357.

Referring to claims 2-3 and 8-9, de Keller discloses a method wherein the player is dealt a plurality of cards and a plurality of community cards to create a poker hand, but does not disclose having a player wagering on a three card poker, five card poker and a seven card poker. However, 357 discloses having a poker game that initially starts out with three cards and a player wagering on a three card hand, a five card wager and a seven card wager and makes a payout to a player based on the rank of the hand. Further, both references pertain to poker games using seven cards. An artisan would be motivated to combine de Keller in view of 357 since multiple wagers would increase the opportunity of larger winnings (increase pot) and create excitement amongst players. This excitement would generate interest for the game and create more player participation, hence, creating more revenue for the casinos that place the games within their gaming room. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add wagering after the three, five and seven card wager, as suggested by 357, into de Keller's game since the incremented successive wagering increases the winnings, thereby increasing excitement among the players.

Referring to claim 4, de Keller in view of 357 discloses a poker game with community cards, but does not disclose that all of the community cards are dealt face down. However, it is notoriously well known in the art to deal the community cards face down in order to generate larger pots. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add dealing the community cards face as known to de Keller's

game in view of 357 in order to increase the size of pots/winnings and increase excitement of play.

Referring to claim 5, de Keller in view of 357 discloses a poker game with community cards, but does not disclose that all of the community cards are dealt face up. However, it is notoriously well known in the art to deal the community cards face up (such as the poker game of Texas Hold'em: In paper #4, Banyai discloses the game of Texas Hold'em). In the game of Texas Hold'em, the community cards are dealt face up and the player cards are dealt incrementally to permit the multiple rounds of wagering in order to increase the pot. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add dealing the community cards face up, as known to de Keller in view of 357, because the cards could be dealt out face up after the player sees the cards in their hands without losing the appeal of risk to the game.

Referring to claims 6 and 12, de Keller discloses using a joker as a wild card (5:51-52).

Referring to claims 7 and 13, de Keller discloses a method of playing poker that includes the capability of using a bonus payout to the player based upon a poker hand being higher than a known rank (5:8-13 and 4:6-19).

Referring to claim 10, de Keller in view of 357 discloses a poker game with community cards and having a betting round to increase the wager prior to the cards being turned face up (5:8-9 and 5:33-50).

Referring to claim 11, de Keller in view of 357 discloses that a player can rescind the seven card wager upon forfeiture of a portion of the seven card poker wager (357 rules). In 357 a player can declare that he/she is out without forfeiting any winnings.

Referring to claim 14, de Keller discloses having a poker game (whether Draw or Stud) wherein a player can receive 4 cards and three community cards to form the best five card poker hand out of seven cards, but does disclose wagering and paying out based on a three card poker hand. However, 357 discloses wagering and paying out based on a three card poker hand. One would be motivated to combine the references in order to accommodate 8 or more players and since both games relate to versions of 7 card stud poker. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate 357's method into de Keller's because the additional betting round could create the possibility of having multiple winners in one hand and generate more interest amongst players.

Referring to claims 15, de Keller discloses using a joker as a wild card.

Referring to claims 16, de Keller discloses a method of playing poker that includes using a bonus payout to the player based upon a poker hand being higher than a known rank.

Claims 17-18 correspond in scope to a method set forth for use of the structure listed in claims 1-16 and are encompassed by use as set forth in the rejection above. It is shown from de Keller that the poker game can be played on either a table type setting or from a video game machine.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingardt (U.S. Patent No. 5,042,818) in view of Jones (U.S. Patent No. 6,402,150). Where "fifty-two cards of a standard deck of cards" is a preamble term that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the term does not limit the structure of the claimed

device. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, the term recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). After reviewing the body of the claims, the Examiner has determined that the claimed invention fails to preclude multiple decks of cards. Further, Weingardt discloses gaming machine storing images of 52 cards of a standard deck (5:44-49).

Weingardt discloses a poker game where a player has an option of placing a five card and seven card wager (4:29-42), the option of playing 5 card draw poker with the first five cards (2:60-3:7), the ability to make a five card payout to the player based on the wager, providing two additional cards faced up, and making a seven card payout to the player based upon rank of five cards in the seven card hand (13:1-50), but does not teach two separate payouts. However, Jones discloses a poker game that has two separate payouts on the same hand (2:49-3:5). Jones (2:49-5:26) teaches a second separate payout in a poker game for distinguishing a modified poker hand from receipt of additional cards or participating in a jackpot or secondary game. Jones suggest adapting "any casino game in which an initial set of cards is dealt, a player reviews the initial set of cards and then the player receives additional cards" (5:27-32). Both references refer to casino card games, specifically to poker. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add an extra payout, as taught by James, to Weingardt's game because it would create a better chance of winning and therefore create more interest among players.

***Response to Arguments***

Applicant's arguments filed February 11, 2003 have been fully considered but they are not persuasive.

Applicant argues, with respect to claim 1, that the Examiner uses improper hindsight since de Keller discloses discarding and replacing cards and that player has an opportunity to make multiple wagers. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, as shown above, de Keller teaches, discloses or suggest a method of playing a game wherein the steps are a dealer dealing cards to a player, providing an opportunity for a player to make a wager on a rank of a poker hand from the cards dealt (4:34-35 and 5:8-9), dealing out community cards (4:39-52), providing an opportunity to make a wager based on cards dealt and the community cards (4:35-38), and settling wagers. de Keller discloses or suggests that the dealer deals the cards to the players, the players have the opportunity to discard the first and/or second card from the dealer and the dealer redeals cards to replace the discarded cards to the players. de Keller does disclose the discarding and replacing cards and that player has an opportunity to make multiple wagers. However, the claimed invention does not exclude de Keller in a manner that distinguishes the Applicant's

invention from de Keller. Therefore, the claimed invention does not preclude the invention of de Keller.

Applicant argues that the apparent defects of 357 should foreclose combining 357 with either de Keller since 357 does not specifically explain how a pot, a winning hand or annie-up works. de Keller and 357 suggests the claimed invention since 357 suggest that a pot is an area on a card table where player's wagers are placed and that when a player wins the 3, 5 or 7 card hand the player receives the pot and the losers match the pot. Further, 357 suggests wagering to play the 3, 5 and 7 card hands by annie-ing up into the pot (wagers to play the current 3,5 or 7 card hands of the game). Since 357 suggests that the losers must match the pot after the 3 card hand suggests that the pot (the players' wagers) was there before the 3 card game took place. Applicant points out that unlike 357 there are no wagers by non-participants and there are no wagers based upon size of a pot during a course of play. However, the claimed invention does not exclude de Keller in a manner that distinguishes the Applicant's invention from de Keller. Therefore, the claimed invention does not preclude the invention of de Keller and 357.

Applicant argues that neither de Keller nor 357 rescinds a wager. However, as 357 points out a player has the option of participating or not in the game. If the player participates and shows the other participants his cards and wins he gets the pot, but if the player loses, he matches the pot. The player not participating would lose his annie-up wager to play the designated game. Therefore, the claimed invention does not preclude the invention of de Keller and 357.

Applicant argues that there is no motivation to combine the references of 357 and de Keller. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, artisan would be motivated to combine de Keller in view of 357 since multiple wagers would increase the opportunity of larger winnings (increase pot) and create excitement amongst players. This excitement would generate interest for the game and create more player participation, hence, creating more revenue for the casinos that place the games within their gaming room.

Applicant argues that there is nothing in de Keller or 357 that suggests making a three card hand from community cards. However, as shown above, de Keller and 357 disclose, teach or suggest that the combination of dealt cards and community cards are used in the determination of the payout. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., three card hand consists of only the community cards) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed invention states that the three card hand has community cards, but does not specifically state that three card hand consist of three community cards. Therefore, the claimed invention does not preclude the invention of de Keller and 357.

The arguments referring to making a three card payout to the player based upon the rank of a three card hand were addressed above.

Applicant argues that there is no mention of stud poker in either Weingardt or Jones so the combination of Weingardt and Jones does not suggest that claimed invention. However, Jones discloses that the game can include games, such as seven card stud (2:12-24; claims 23, 54, 88, etc...). Therefore, the claimed invention does not preclude the invention of de Keller and 357.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
April 5, 2003

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